



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,085	12/19/2003	Hiroshi Hagino	246754US	9926

22850 7590 09/13/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

JONES, DWAYNE C

ART UNIT PAPER NUMBER

1614

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/739,085

Applicant(s)

HAGINO ET AL.

Examiner

Dwayne C. Jones

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29JUN2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29/06; 7/14/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 8-24 are pending.
2. Claims 8-24 are rejected.

Information Disclosure Statement

3. The information disclosure statements filed on June 29, 2006 (1 sheet) and July 14, 2006 (1 sheet) have been reviewed and considered, see enclosed copy of PTO FORM 1449.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Naoki of JP 61-087614, May 6, 1986. This claim is defined as a product-by-process claim and is a product, not a process, see In re Bridgeford, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see In re Brown, 459 F2d 531, 173 USPQ 685 (CCPA 1972); In re Wertheim, 541 F2d, 191 USPQ (CCPA 1976). A comparison of the recited process with the prior art processes does not serve to resolve the issue concerning the patentability of the product, see In re Fessman, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Naoki teaches of cosmetics that are made from

Art Unit: 3991

algae, which includes the seaweed of laver. Naoki also teach of process steps of decomposing the algae by acid hydrolysis, (see abstract).

6. Claims 8-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Albitskaya, O. N. et al. of RU 2,044,770 of September 27, 1995. This claim is defined as a product-by-process claim and is a product, not a process, see In re Bridgeford, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see In re Brown, 459 F2d 531, 173 USPQ 685 (CCPA 1972); In re Wertheim, 541 F2d, 191 USPQ (CCPA 1976). A comparison of the recited process with the prior art processes does not serve to resolve the issue concerning the patentability of the product, see In re Fessman, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Albitskaya, O. N. et al. teach of cosmetic compositions of the seaweed of Chlorella, (see abstract). In addition, Albitskaya, O. N. et al. even teach that the Chlorella is subjected to hydrolysis via proteolytic enzymes in order to obtain the protein hydrolysate.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3991

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naoki teaches of cosmetics that are made from algae, which includes the seaweed of laver. Naoki also teach of process steps of decomposing the algae by acid hydrolysis, (see abstract). One having ordinary skill in the art would have been motivated to substitute seaweed for another. Moreover, since claims 4-7 are defined as a product-by-process claims and these claims are regarded as a product, not a process, see In re Bridgeford, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see In re Brown, 459 F2d 531, 173 USPQ 685 (CCPA 1972); In re Wertheim, 541 F2d, 191 USPQ (CCPA 1976). For these reasons, one having ordinary skill in the art would view the Naoki teachings of the cosmetic compositions that are made from algae, which includes the seaweed of laver as products rather than process claims obtained by procedural steps.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 8-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 14, 15, and 20 of U.S. Patent No. 6,217,879.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims as well as U.S. Patent No. 6,217,879 teach of seaweed compositions, such as laver, and methods of subjecting the seaweed to enzyme hydrolysis, such as pepsin and even peptidase, in order to arrive at an enzyme-decomposed material from seaweed in order to increase the level of free amino acids, which would result in decreasing the amount of various derivative groups, such as esters, acyl groups, salts and cations, and silylated or silicon-ester groups. U.S. Patent No. 6,217,879 also teach of after boiling the laver adjusted the pH to 2 with HCl and pepsin, (see Example 1). One having ordinary skill in the art would have been motivated to substitute one seaweed for another. In addition, it is noted that the

Art Unit: 3991

instant claims are only directed to composition claims with an intended use recitation, such as for use as a cosmetic, *In re Hack*, 114 USPQ 161. Accordingly, one having ordinary skill in the art would have found the instant composition claims to rendered obvious, if not anticipated, by the seaweed compositions of the prior art reference of U.S. Patent No. 6,217,879.

13. Claims 8-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 12 of copending Application No. 11/078,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims as well as copending Application No. 11/078,617 teach of cosmetic compositions of algal proteins of the seaweed of *Porphyra*. In addition, copending Application No. 11/078,617 disclose of steps to remove (dissociate a salt, namely Na, K, Ca, etc., from the acid moiety of the sulfate group of the *Porphyra*), which would embrace the instantly claimed step of removing any cationized groups from the seaweeds of the instant claims. Moreover, since claims 4-7 are defined as a product-by-process claims and these claims are regarded as a product, not a process, see *In re Bridgeford*, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 541 F2d, 191 USPQ (CCPA 1976). For these reasons, one having ordinary skill in the art would view the teachings of the cosmetic compositions of algal proteins of the seaweed of *Porphyra* as copending Application No. 11/078,617 as products rather than process claims obtained by procedural steps.

14. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3991

15. Claims 8-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 12 of copending Application No. 10/652,069. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims as well as copending Application No. 10/652,069 teach of seaweed protein-containing compositions from the genus of *Porphyra*. In addition, it is noted that the instant claims are only directed to composition claims with an intended use recitation, such as for use as a cosmetic, *In re Hack*, 114 USPQ 161. Accordingly, one having ordinary skill in the art would have found the instant composition claims to be rendered obvious, if not anticipated, by the seaweed compositions of the prior art reference of U.S. Patent No. 6,217,879. Moreover, since claims 4-7 are defined as a product-by-process claims and these claims are regarded as a product, not a process, see *In re Bridgeford*, 357 F.2d 679, 149 USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Wertheim*, 541 F.2d, 191 USPQ (CCPA 1976). For these reasons, one having ordinary skill in the art would view the teachings of the cosmetic compositions of algal proteins of the seaweed of *Porphyra* as copending Application No. 10/652,069 as products rather than process claims obtained by procedural steps.

16. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

17. Applicants' arguments filed June 29, 2006 have been fully considered but they are not persuasive. Applicants present the following arguments for the instant claims. However, it is

Art Unit: 3991

first noted that the instant claims are defined as a product-by-process claim and is a product, not a process, see In re Bridgeford, 357 F2d 679, 149, USPQ 5 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established, see In re Brown, 459 F2d 531, 173 USPQ 685 (CCPA 1972); In re Wertheim, 541 F2d, 191 USPQ (CCPA 1976). A comparison of the recited process with the prior art processes does not serve to resolve the issue concerning the patentability of the product, see In re Fessman, 489 F2d 742, 180 USPQ 324 (CCPA 1974). For these reasons and those of record the rejections of record are sustained because Naoki and Albitskaya, O. N. et al. meet the limitations of instant claims 8-24. Moreover, the double patenting rejections over U.S Patent No. 6,217,879 and the provisional double patenting rejections over 11/078,617 and 10/652,069 are sustained for reasons of record and further because the instant claims are product-by-process claims.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3991

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (571) 272-0578. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, and Fridays from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, may be reached at (571) 272-0718. The official fax No. for correspondence is (571)-273-8300.

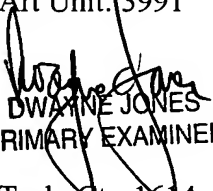
Also, please note that U.S. patents and U.S. patent application publications are no longer supplied with Office actions. Accordingly, the cited U.S. patents and patent application publications are available for download via the Office's PAIR, see <http://pair-direct.uspto.gov>. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll free).

Application/Control Number: 10/739,085

Page 10

Art Unit: 3991


DWAINE JONES
PRIMARY EXAMINER

Tech. Ctr. 1614

September 7, 2006